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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,810	02/17/2000	Kyoko Kawaguchi	32410	7331

116 7590 05/03/2004
PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/505,810

Applicant(s)

KAWAGUCHI ET AL.

Examiner

Alain L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 22-30, 39-45, 48, 49, 54-70 and 72-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 22-30, 39-45, 48-49, 54-70, and 72-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 14-19, 21, 33-38, 46-47, 50-53, and 71 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 17.

Response to Arguments

2. In view of the appeal brief filed on 11-3-03, PROSECUTION IS HEREBY REOPENED. A new non-final rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options once a new grounds of rejection is made:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Cancellation of claims withdrawn from consideration must be included if reinstatement of the appeal is requested.

3. The amendment after-final (filed 7-7-03) has been entered only in part. Claims 20, 31-32 indicated in both the after-final and the appeal brief were previously canceled in the amendment filed May 21, 2002 of paper number 7.

Claim Rejections - 35 USC § 112

4. Claims 67-70 are rejected as failing to include every limitation of the claim from which they depend, as required under 35 U.S.C 112, fourth paragraph. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The fact that independent and dependant claims are of different statutory classes does not, in itself, render the latter improper. The test as to whether a claim is a proper dependant claim is that it shall include every limitation of the claim from which it depends (35 U.S.C 112, fourth paragraph), or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim. See MPEP 608.01(n).

Regarding the example at hand, since a computer readable medium, such as that of claims 67-70 may perform other methods, it is not a proper dependant claim.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8, 23-25, 39-45, 48-49, 54-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (396) in view of Sasmazel et al.

Walker et al discloses an electronic utilization system and method. A terminal (300) outputs a signal for a desired asset (attendance of an event i.e. booking). An exchange certificate (offers displayed to the user) with content (fig 5a-5b) verifies a user's right to receive an electronic asset (see col 11, lines 51-67; col 12, lines 1-16).

The original ticket number and seat location described by Walker et al is considered a electronic asset.

Settlement and status information are present (col 11, lines 20-38; col 12, lines 15-16). An expiration date is also utilized for the certificates.

With respect to the claimed recitation that the terminal generates a sound, it would be obvious to one with ordinary skill in the art to include sound generation for user attention purposes.

Walker et al (396) does not explicitly disclose:

transmitting of the desired electronic asset on a predetermined date and time.

Sasmazel et al discloses exchange certificates and electronic assets that expire on a predetermined date and time (col 8, lines 26-44).

It would have been obvious to one with ordinary skill in the art to include transmitting of the desired electronic asset on a predetermined date and time because Walker et al (396) teaches that his offers are time limited (col 8, lines 4-10) and Sasmazel et al teaches date and time are sensitive parameters due to expiration (col 8, lines 26-44).

7. Claims 9-13, 22, 54, 72-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (396) in view of Sasmazel et al as applied to claims 1-8, 23-25, 39-45, 48-49, 54-70 above, and further in view of Hughes.

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Walker et al (396) and Sasmazel et al do not explicitly use the terminology "past-due date" regarding re-transmissions.

Hughes discloses re-transmission of transaction messages (col 9, lines 45-67). It would have been obvious to one with ordinary skill in the art to include re-transmission after a past-due date to Williams et al in view of Walker et al because Hughes teaches misinterpretation and misunderstandings in transaction information between parties (col 2, lines 1-43).

8. Claims 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (396) in view of Sasmazel et al as applied to claims 1-8, 23-25, 39-45, 48-49, 54-70 above, and further in view of Kwan.

Kwan discloses mobile terminal use (fig 4).

It would have been obvious to one with ordinary skill in the art to claim a mobile terminal as claimed in application 09/506,545 to the instant application because Kwan teaches need of financial data transmission by other than hard wire (col 1, 63-67; col 2, lines 1-4).

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Double Patenting

9. Claims 1 and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/506,545. Although the conflicting claims are not identical, they are not patentably distinct from each other because there are minor variations within ordinary skill in the art for each set of claims.

Response to Arguments

10. Applicant's arguments with respect to claims of record have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alain L. Bashore